



DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Madrid Protocol

ACTION: Proposed collection; comment request.

SUMMARY: The United States Patent and Trademark Office (USPTO), as part of its continuing effort to reduce paperwork and respondent burden, invites the general public and other Federal agencies to take this opportunity to comment on the continuing information collection, as required by the Paperwork Reduction Act of 1995, Public Law 104-13 (44 U.S.C. § 3506(c)(2)(A)).

DATES: Written comments must be submitted on or before [INSERT DATE 60 DAYS AFTER THE DATE OF PUBLICATION IN THE FEDERAL REGISTER].

ADDRESSES: You may submit comments by any of the following methods:

- E-mail: InformationCollection@uspto.gov. Include "0651-0051 comment" in the subject line of the message.
- Mail: Susan K. Fawcett, Records Officer, Office of the Chief Information Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.
- Federal Rulemaking Portal: <http://www.regulations.gov>.

FOR FURTHER INFORMATION CONTACT: Requests for additional information should be directed to Sharon Marsh, Deputy Commissioner for Trademark Examination Policy, Office of the Commissioner for Trademarks, United States Patent and Trademark Office, P.O. Box 1451, Alexandria, VA 22313-1451, by telephone at 571-272-8900, or by e-mail to Sharon.Marsh@uspto.gov. Additional information about this collection is also available at <http://www.reginfo.gov> under "Information Collection Review."

SUPPLEMENTARY INFORMATION

I. Abstract

This collection of information is required by the Trademark Act of 1946, 15 U.S.C. § 1051 *et seq.*, which provides for the Federal registration of trademarks, service marks, collective trademarks and service marks, collective

membership marks, and certification marks. Individuals and businesses that use or intend to use such marks in commerce may file an application to register the marks with the United States Patent and Trademark Office (USPTO).

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks ("Madrid Protocol") is an international treaty that allows a trademark owner to seek registration in any of the participating countries by filing a single international application. The International Bureau (IB) of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland, administers the international registration system. The Madrid Protocol Implementation Act of 2002 amended the Trademark Act to provide that: (1) the owner of a U.S. application or registration may seek protection of its mark in any of the participating countries by submitting a single international application to the IB through the USPTO, and (2) the holder of an international registration may request an extension of protection of the international registration to the United States. The Madrid Protocol became effective in the United States on November 2, 2003, and is implemented under 15 U.S.C. § 1141 *et seq.* and 37 CFR Part 2 and Part 7.

An international application submitted through the USPTO must be based on an active U.S. application or registration and must be filed by the owner of the application or registration. The USPTO reviews the international application to certify that it corresponds to the data contained in the existing U.S. application or registration before forwarding the international application to the IB. The IB then reviews the international application to determine whether the Madrid filing requirements have been met and the required fees have been paid. If the international application is unacceptable, the IB will send a notice of irregularity to the USPTO and the applicant. The applicant must respond to the irregularities to avoid abandonment, unless a response from the USPTO is required. After any irregularities are corrected and the application is accepted, the IB registers the mark, publishes the registration in the WIPO Gazette of International Marks, and sends a certificate to the holder.

When the mark is registered, the IB notifies each country designated in the application of the request for extension of protection. Each designated country then examines the request under its own laws. Once an international registration has been issued, the holder may

also file subsequent designations to request an extension of protection to additional countries.

Under Section 71 of the Trademark Act, a registered extension of protection to the United States will be cancelled unless the holder of the international registration periodically files affidavits of continued use in commerce or excusable nonuse. The first affidavit must be filed five years after the USPTO registers an extension of protection.

This collection includes the information necessary for the USPTO to process applications for international registration and related requests under the Madrid Protocol. The USPTO provides electronic forms for filing the items in this information collection online (except for the Request to Record an Assignment or Restriction of a Holder's Right to Dispose of an International Registration) using the Trademark Electronic Application System (TEAS), which is available through the USPTO Web site. The USPTO is proposing to add one item, the Combined Declaration of Continued Use/Excusable Nonuse and Incontestability Under Sections 71 and 15, which is an existing information requirement that was not previously covered under this collection.

Applicants may also submit the items in this collection on paper or by using the forms provided by the IB, which are available on the WIPO Web site. The IB requires Applications for International Registration and Applications for Subsequent Designation that are filed on paper to be submitted on the official IB forms.

II. Method of Collection

By mail, hand delivery, or electronically to the USPTO.

III. Data

OMB Number: 0651-0051.

Form Number(s): PTO-1553, PTO-1583, PTO-2131, PTO-2132, PTO-2133.

Type of Review: Revision of a currently approved collection.

Affected Public: Individuals or households; businesses or other for-profits; and not-for-profit institutions.

Estimated Number of Respondents: 6,620 responses per year.

Estimated Time Per Response: The USPTO estimates that it will take the public approximately 15 minutes to one hour and 15 minutes (0.25 to 1.25 hours) to complete the information in this collection, including the time to gather

the necessary information, prepare the forms or documents, and submit the completed request to the USPTO.

Estimated Total Annual Respondent Burden Hours: 1,711 hours.

Estimated Total Annual Respondent Cost Burden: \$581,740. The USPTO expects that the information in this collection will be prepared by attorneys. Using the estimated rate of \$340 per hour for attorneys in private firms, the USPTO estimates that the respondent cost burden for submitting the information in this collection will be approximately \$581,740 per year.

Item	Estimated time for response	Estimated annual responses	Estimated annual burden hours
Application for International Registration (PTO-2131 TEAS)	15 minutes	3,900	975
Application for International Registration (paper, no form)	30 minutes	20	10
Application for Subsequent Designation (PTO-2132 TEAS)	15 minutes	400	100
Application for Subsequent Designation (paper, no form)	20 minutes	5	2
Response to Notice of Irregularity (PTO-2133 TEAS)	15 minutes	1,000	250
Response to Notice of Irregularity (paper, no form)	30 minutes	5	3
Replacement Request (TEAS Global form)	30 minutes	15	8
Replacement Request (paper, no form)	45 minutes	5	4
Request to Record an Assignment or Restriction of a Holder's Right to Dispose of an International Registration (paper, no form)	30 minutes	5	3
Transformation Request (TEAS Global form)	15 minutes	20	5
Transformation Request (paper, no form)	30 minutes	10	5

Item	Estimated time for response	Estimated annual responses	Estimated annual burden hours
Petition to Director to Review Denial of Certification of International Application (TEAS Global form)	1 hour	30	30
Petition to Director to Review Denial of Certification of International Application (paper, no form)	1 hour and 15 minutes	5	6
Declaration of Continued Use/Excusable Nonuse of Mark in Commerce Under Section 71 (PTO-1553 TEAS)	15 minutes	700	175
Declaration of Continued Use/Excusable Nonuse of Mark in Commerce Under Section 71 (paper, no form)	18 minutes	100	30
Combined Declaration of Continued Use/Excusable Nonuse and Incontestability Under Sections 71 and 15 (PTO-1583 TEAS)	15 minutes	300	75
Combined Declaration of Continued Use/Excusable Nonuse and Incontestability Under Sections 71 and 15 (paper, no form)	18 minutes	100	30
Totals		6,620	1,711

Estimated Total Annual Non-hour Respondent Cost Burden: \$745,480. This collection has annual (non-hour) costs in the form of filing fees and postage costs.

The USPTO charges fees for processing international applications and related requests under the Madrid Protocol as set forth in 37 CFR 7.6. In addition to these USPTO fees, applicants must also pay international filing fees to the IB as indicated in 37 CFR 7.7. The USPTO estimates that the total filing fees in the form of USPTO processing fees associated with this collection will be approximately \$745,250 per year as calculated in the accompanying table.

Item	Estimated annual responses	Fee amount	Estimated annual filing costs
Application for International Registration (for certifying an international application based on a single basic application or registration, per international class) (PTO-2131 TEAS)	2,000	\$100.00	\$200,000.00
Application for International Registration (for certifying an international application based on a single basic application or registration, per international class) (paper, no form)	10	\$100.00	\$1,000.00
Application for International Registration (for certifying an international application based on more than one basic application or registration, per international class) (PTO-2131 TEAS)	1,900	\$150.00	\$285,000.00
Application for International Registration (for certifying an international application based on a single basic application or registration, per international class) (paper, no form)	10	\$150.00	\$1,500.00
Application for Subsequent Designation (PTO-2132 TEAS)	400	\$100.00	\$40,000.00
Application for Subsequent Designation (paper, no form)	5	\$100.00	\$500.00
Response to Notice of Irregularity (PTO-2133 TEAS)	1,000	\$0.00	\$0.00
Response to Notice of Irregularity (paper, no form)	5	\$0.00	\$0.00
Replacement Request (per international class) (TEAS Global form)	15	\$100.00	\$1,500.00
Replacement Request (per international class) (paper, no form)	5	\$100.00	\$500.00
Request to Record an Assignment or Restriction of a Holder's Right to Dispose of an International Registration (paper, no form)	5	\$100.00	\$500.00
Transformation Request (TEAS Global form)	20	\$375.00	\$7,500.00
Transformation Request (paper, no form)	10	\$375.00	\$3,750.00
Petition to Director to Review Denial of Certification of International Application (TEAS Global form)	30	\$100.00	\$3,000.00
Petition to Director to Review Denial of Certification of International Application (paper, no form)	5	\$100.00	\$500.00
Declaration of Continued Use/Excusable Nonuse of Mark in Commerce Under Section 71 (per international class) (PTO-1553 TEAS)	700	\$100.00	\$70,000.00
Declaration of Continued Use/Excusable Nonuse of Mark in Commerce Under Section 71 (per international class) (paper, no form)	100	\$100.00	\$10,000.00

Item	Estimated annual responses	Fee amount	Estimated annual filing costs
Combined Declaration of Continued Use/Excusable Nonuse and Incontestability Under Sections 71 and 15 (per international class) (PTO-1583 TEAS)	300	\$300.00	\$90,000.00
Combined Declaration of Continued Use/Excusable Nonuse and Incontestability Under Sections 71 and 15 (per international class) (paper, no form)	100	\$300.00	\$30,000.00
Totals	6,620		\$745,250.00

The public may submit the items in this collection to the USPTO by mail through the United States Postal Service. The USPTO estimates that approximately 255 of the 6,620 total responses for this collection may be filed on paper and submitted by mail. The average first-class postage cost for a mailed submission will be 90 cents, for a total postage cost of approximately \$230 per year.

The total non-hour respondent cost burden for this collection in the form of filing fees and postage costs is estimated to be \$745,480 per year.

IV. Request for Comments

Comments are invited on: (a) whether the proposed collection of information is necessary for the proper performance of the functions of the agency, including whether the information shall have practical utility; (b) the accuracy of the agency's estimate of the burden

(including hours and cost) of the proposed collection of information; (c) ways to enhance the quality, utility, and clarity of the information to be collected; and (d) ways to minimize the burden of the collection of information on respondents, e.g., the use of automated collection techniques or other forms of information technology.

Comments submitted in response to this notice will be summarized or included in the request for OMB approval of this information collection; they also will become a matter of public record.

Dated: January 6, 2012

Susan K. Fawcett,
Records Officer, USPTO,
Office of the Chief Information Officer.

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